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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,023	06/30/2003	Kentaro Yano	00862 023118	4222
5514 7590 05/23/2008 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112				
EXAMINER				
PARK, CHAN S				
ART UNIT		PAPER NUMBER		
2625				
MAIL DATE		DELIVERY MODE		
05/23/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/608,023

Applicant(s)

YANO ET AL.

Examiner

CHAN S. PARK

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35-38 and 40-62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35-38 and 40-62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/26/08 has been entered.

Response to Amendment

2. Applicant's amendment was received on 2/26/08, and has been entered and made of record. Currently, **claims 35-38 and 40-62** are pending.

Response to Arguments

3. Applicant's arguments with respect to claims 35-38 and 40-62 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

4. Claims are objected to because of the following informalities:

Claim 42, line 8, "for controlling a" should be -- for controlling a user interface --;

Claim 51, line 7, "of the supply" should be -- of the image supply --.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 35 and 36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims recite the limitation of “determining a presence/absence and comparative merits of ... an operation controller for controlling a user interface of the recording system”. The examiner finds no support in the Specification where it describes said assignment means determining a presence/absence and comparative merits of the operation controller for controlling a user interface. Paragraphs 98 and 104 (refer to the corresponding Patent Application Publication 2004/0046990) only describe the operation controller for receiving “Service 807” and “Data list 805”. The examiner respectfully requests the applicant to specifically point out how the presence/absence and comparative merits of the operation controller for controlling a user interface is determined by said assignment means.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 42-47, 49, 50, 55, 57 and 58 are rejected under 35 U.S.C. 102(b) as being anticipated by Rissman U.S. Patent No. 6,552,743.

With respect to claim 43, Rissman teaches a control method of a print system, in which an image supply device and a printing device directly communicate with each other via a communication interface (figs. 1 & 2), for transmitting image data to the recording device from the image supply device and printing the image data (col. 4, lines 40-47), the method comprising the steps of:

establishing a communication procedure between the image supply device and the printing device (communication links 18-23 in col. 4, lines 19-39);

after the establishment of the communication procedure, assigning at least an operation controller for controlling a user interface of the print system (processor 50 controlling display 32 in col. 5, lines 31-34); and

transmitting/receiving image data and a communication command between the image supply device and the printing device based on an assignment assigned in said assigning step, and performing a print operation by using the printing device based on the image data supplied from the image supply device (printing the selected images in col. 6, lines 31-39),

wherein the image data is selected using the operation controller assigned in said assigning step (selecting images in col. 6, lines 22-30).

With respect to claim 42, arguments analogous to those presented for claim 43, are applicable.

With respect to claim 44, Rissman teaches a control method according to claim 43, wherein the communication interface sets that the printing device is host and the image supply device is slave and said assigning step is implemented by the printing device (printer instructing the camera to transmit the images in col. 8, lines 26-35).

With respect to claim 45, Rissman teaches a control method according to claim 43, wherein the image supply device and the printing device can communicate using a plurality of communication methods, and the image supply device or the printing device has a dedicated protocol for each of the plurality of communication methods (note each interface uses different protocols in col. 8, lines 8-25).

With respect to claim 46, Rissman teaches a control method according to claim 45, wherein in said assigning step, an assignment of functions to the image supply device and the printing device differs in accordance with the communication method

between the image supply device and the printing device (note that assignment of interface differs in accordance with the communication method in col. 5, lines 60-65).

With respect to claim 47, Rissman discloses a printing device for directly communicating with an image supply device via a communication interface (figs. 1 & 2) and for receiving image data from the image supply device to print the image data (col. 4, lines 40-47), the printing device comprising:

communication means for establishing a communication procedure with the image supply device (communication links 18-23 in col. 4, lines 19-39);

assignment means for, after the establishment of the communication procedure, assigning at least an operation controller for controlling a user interface of the printing device (processor 50 controlling display 32 in col. 5, lines 31-34); and

print control means for receiving the image data from the image supply device and printing the image data based on an assignment assigned by said assignment means (printing the selected images in col. 6, lines 31-39),

wherein the image data is selected using the operation controller assigned by said assignment means (selecting images in col. 6, lines 22-30).

With respect to claim 49, Rissman discloses a printing device according to claim 47, wherein the printing device can communicate using a plurality of communication methods, and an assignment of functions to the image supply device and the printing device differs in accordance with the communication method with the image supply device (note that assignment of interface differs in accordance with the communication method in col. 5, lines 60-65).

With respect to claim 50, Rissman discloses a printing device according to claim 47, wherein functions further include at least one of an image format supporting function, layout print function, date and file name print function, image correction function, fixed size print function, image clipping print function and print job format supporting function (col. 5, lines 35-40 & col. 6, lines 8-21).

With respect to claim 55, arguments analogous to those presented for claim 47, are applicable.

With respect to claim 57, arguments analogous to those presented for claim 49, are applicable.

With respect to claim 58, arguments analogous to those presented for claim 50, are applicable.

7. Claims 51-54 and 59-62 are rejected under 35 U.S.C. 102(e) as being anticipated by Kakigi et al. U.S. Patent No. 7,106,461 (hereinafter Kakigi).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

With respect to claim 51, Kakigi discloses an image supply device for directly communicating with a printing device via a communication interface and for transmitting image data to the printing device to print the image data (figs. 33~35), the image supply device comprising:

communication means for establishing a communication procedure with the printing device (col. 43, lines 62-65);

assignment means for, after the establishment of the communication procedure, assigning at least an operation controller for controlling a user interface of the supply device (displaying the information about the printer via the printer display 2 in figs. 34 & 35); and

print control means for transmitting image data to the printing device and causing the printing device to print based on an assignment assigned by said assignment means (col. 45, lines 3-7),

wherein the image data is selected using the operation controller assigned by said assignment means (designating/selecting images in col. 41, lines 20-38).

With respect to claim 52, Kakigi discloses an image supply device according to claim 51, wherein said assignment means receives function information describing functions of the printing device after the establishment of the communication procedure, and assigns functions based on the received function information (col. 44, lines 37-47).

With respect to claim 53, Kakigi discloses an image supply device according to claim 51, wherein the image supply device can communicate using a plurality of communication methods, and an assignment of functions to the image supply device

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and the printing device differs in accordance with the communication method with the printing device (note that assignment of interface differs in accordance with the communication method in col. 37, lines 26-33).

With respect to claim 54, Kakigi discloses an image supply device according to claim 51, wherein functions further include at least one of an image format supporting function, layout print function, date and file name print function, image correction function, fixed size print function, image clipping print function and print job format supporting function (col. 37, lines 53-66).

With respect to claims 59-62, arguments analogous to those presented for claims 51-54, are applicable respectively.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 35-38, 40 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Breidenbach et al. U.S. Patent Application Publication No. 2003/0084085 (hereinafter Breidenbach) in view of Tanaka et al. U.S. Patent Application Publication No. 2001/0048534 (hereinafter Tanaka).

With respect to claim 36, Breidenbach teaches a control method of a recording system, in which an image supply device and a recording device directly communicate

with each other via a communication interface, for transmitting image data to the recording device from the image supply device and recording the image data, the method comprising the steps of:

establishing a communication procedure between the image supply device and the recording device (paragraphs 43-44 & 47);

determining a presence/absence and comparative merits of each of a plurality of functions of the image supply device and the recording device, after the establishment of the communication procedure (paragraphs 46, 49 & 50), wherein the plurality of functions include an operation controller for controlling a user interface of the recording (displaying the corresponding icons in figs. 7A & 7B);

assigning the plurality of functions to the image supply device and the recording device based on the presence/absence and comparative merits of each of the plurality of functions determined in said determining step (paragraphs 46, 49 & 50); and

transmitting/receiving image data and a communication command between the image supply device and the recording device based on the functions assigned in said assigning step, and performing a recording operation by using the recording device based on the image data supplied from the image supply device (paragraphs 52~54).

Breidenbach, however, does not explicitly disclose the method wherein the image data is selected using the operation controller assigned in said assigning step.

Tanaka discloses a recording system having a digital camera directly connected to a printer for transmitting specified image file wherein the specified image file is automatically printed by the printer (fig. 7 and S144~S146 of fig. 8).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the digital camera of Breidenbach to include the function of selecting specific image file for automatic printing as taught by Tanaka.

The suggestion/motivation for doing so would have been to provide the automatic printing upon detecting the capabilities of each device.

Therefore, it would have been obvious to combine Breidenbach with Tanaka to obtain the invention as specified in claim 36.

With respect to claim 35, arguments analogous to those presented for claim 36, are applicable.

With respect to claim 37, Breidenbach teaches a control method according to claim 36, wherein the communication interface sets that the recording device is host and the image supply device is slave and said determining step and said assigning step are implemented by the recording device (paragraphs 49~54). Since the scanner/digital camera is adjusts its option based on the printer capability, the printer is acting as the host and the scanner/digital camera is acting as the slave.

With respect to claim 38, Breidenbach teaches a control method according to claim 36, wherein the communication interface sets that the recording device is host and the image supply device is slave and said determining step and said assigning step are implemented by the image supply device (paragraph 49).

With respect to claim 40, Breidenbach teaches a control method according to claim 36, wherein in said determining step, function information is received from a communication partner after the establishment of the communication procedure, and in

said assigning step, the plurality of functions are assigned based on the received function information (paragraph 50).

With respect to claim 41, Breidenbach teaches a control method according to claim 36, wherein the plurality of functions include at least one of an image format supporting function, layout print function, date and file name print function, image correction function, fixed size print function, image clipping print function and print job format supporting function (paragraphs 52~56).

9. Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rissman as applied to claim 47 above, and further in view of Breidenbach.

With respect to claim 48, Rissman discloses a printing device according to claim 47, but it does not explicitly disclose that said assignment means receives function information describing functions of the image supply device after the establishment of the communication procedure, and assigns functions based on the received function information.

Breidenbach discloses a recording system including a printing device and a digital camera wherein the printing device and the digital camera exchange their capability information to enable the devices to dynamically configure and modify its capability and functionality based on the information exchanged (paragraphs 45-46).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the printing device of Rissman to receive the functionality information from the digital camera as taught by Breidenbach.

The suggestion/motivation for doing so would have been to dynamically configure and modify its capability and functionality based on the information exchanged.

Therefore, it would have been obvious to combine Rissman with Breidenbach to obtain the invention as specified in claim 48.

10. Claim 56 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rissman as applied to claim 55 above, and further in view of Breidenbach.

With respect to claim 56, arguments analogous to those presented for claim 48, are applicable.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S. PARK whose telephone number is (571)272-7409. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CHAN S PARK/
Examiner, Art Unit 2625

May 21, 2008